

REMARKS

Entry of the foregoing amendments is respectfully requested.

Summary of Amendments

Upon entry of the foregoing amendments claims 97, 98, 100 and 101 are amended, claims 130, 137 and 142-144 are cancelled and claims 147-151 are added, whereby 82-101, 103-129, 131-136, 138-141 and 146-151 will be pending, with claims 82, 126 and 146 being independent claims.

Support for the new claims can be found throughout the present specification.

Applicants point out that the amendments to claims 97, 98, 100 and 101 and the cancellation of claims 130, 137 and 142-144 are without prejudice or disclaimer, and Applicants expressly reserve the right to prosecute the cancelled claims and the amended claims in their original, unamended form in one or more continuation and/or divisional applications.

Summary of Office Action

As an initial matter, Applicants note with appreciation that the Examiner has withdrawn the rejection of claims 82-101 and 103-125 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Riedel et al., U.S. Patent No. 6,558,680 in view of Chapin et al., U.S. Patent No. 4,370,319.

Applicants further note that the Examiner has withdrawn the allowance of claims 126-144.

Claims 82-101, 103-144 and 146, i.e., all claims under consideration, are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.

Response to Office Action

Reconsideration and withdrawal of the rejections of record are respectfully requested, in view of the foregoing amendments and the following remarks.

Claims 29, 30 and 32-47 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. The rejection essentially asserts that the specification as originally filed fails to provide sufficient written basis of any of the allegedly broad terms recited in the present claims such as, e.g., C₁₂₋₄₀ fatty acids, and thus allegedly does not convey the impression that Applicants were in possession of the invention as recited in the present claims.

Applicants respectfully traverse this rejection. Initially, the Examiner is reminded of the comments in MPEP 2163 II. A. (emphases added):

Office personnel should adhere to the following procedures when reviewing patent applications for compliance with the written description requirement of 35 U.S.C. 112, para. 1. The examiner has the initial burden, after a thorough reading and evaluation of the content of the application, of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claims. There is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed, *Wertheim*, 541 F.2d at 262, 191 USPQ at 96; ... Consequently, rejection of an original claim for lack of written description should be rare. The inquiry into whether the description requirement is met is a question of fact that must be determined on a case-by-case basis. See *In re Smith*, 458 F.2d 1389, 1395, 173 USPQ 679, 683 (CCPA 1972) ("Precisely how close [to the claimed invention] the description must come to comply with Sec. 112 must be left to case-by-case development."); *In re Wertheim*, 541 F.2d at 262, 191 USPQ at 96 (inquiry is primarily factual and depends on the nature of the invention and the amount of knowledge imparted to those skilled in the art by the disclosure).

Applicants further point out that each genus which is recited in the present claims and mentioned in the present Office Action is supported by the recitation of a number of structurally diverse species which are encompassed by the corresponding genus. In this regard, the Examiner's attention is particularly directed to the following passages of the present specification:

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C₁₂-C₄₀ fatty acids: page 13, lines 6-23;

C₁₂-C₄₀ fatty alcohols: page 13, line 25 to page 14, line 1;

amphiphilic and associative polymers: page 14, line 26 to page 20, end of table;

siloxane elastomers: page 20, paragraph following table to page 23, line 2 after table;

C₁₂-C₄₀ polyethoxylated fatty acid esters having a polyethoxy chain length of from 10 to 100: page 14, lines 3-17;

low molecular weight surfactant: page 23, lines 5-8;

pigments and dyes: page 4, line 2 from bottom, to page 13, line 4;

polar lipids having a polarity of at the most 30mN/m: page 27, line 11 to bottom of page 28;

solubilizers: page 26, lines 5-16;

photoprotective filters: page 35, line 31 to page 47, line 20;

moisturizers: page 48, lines 7-17;

active ingredients: page 49, line 15 to page 50, line 5;

powder raw materials: page 48, line 19 to page 49, line 2;

preservatives: page 47, line 25 to page 48, line 5;

fillers: page 57, last row of table.

In addition, the Examiner's attention is directed to the 16 exemplary compositions set forth at pages 51-58 of the present specification, which compositions comprise several examples of species which are encompassed by the generic components recited in the present claims.

In view of the facts set forth above there can be no reasonable doubt that Applicants were in possession of each genus that is recited in the present claims. It further is pointed out that the new claims submitted herewith do not recite any genus at all.


Applicants submit that for at least all of the foregoing reasons, the present rejection under 35 U.S.C. § 112, first paragraph, should be withdrawn, which action is respectfully requested.

CONCLUSION

In view of the foregoing, it is believed that all claims in the present application are in condition for allowance, which action is again respectfully requested. If any issues yet remain which can be resolved by a telephone conference, the Examiner is respectfully invited to contact the undersigned at the telephone number below.

Applicants point out that a Supplemental Information Disclosure Statement is being filed concurrently herewith. Accordingly, the Examiner is respectfully requested to indicate consideration of this Information Disclosure Statement by returning a signed and initialed copy of the form PTO-1449 submitted therein.

Respectfully submitted,
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